

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicant would like to thank the Examiner for the indication that claims 12, 16 and 20 contain allowable subject matter and would be allowed if rewritten in independent form including all of the limitations of their base claim and any intervening claims.

In the Official Action, the Examiner rejects claims 3-7 and 45-47 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 3-7, the Examiner argues that the language “the X-ray chip is disposed in a projected state outside a diametric direction with respect to an axis of the second cylindrical member in a state in which the stent is disposed in the second cylindrical member” contains ambiguities and is unclear. In response, claim 3 has been amended to clarify the features recited therein.

With regard to claims 45-47, the Examiner argues that the same are also unclear for the following reasons:

(a) The claims recite that the second cylindrical member is inserted inside the first cylindrical member and the stent is charged in the second cylindrical member. However, the Examiner finds that the stent is charged over the second cylindrical member by the first cylindrical member. In response, claims 45 -47 have been amended as suggested by the Examiner.

(b) The claims also recite “pulling the first cylinder member out of the second cylindrical member” while the claims already establish that the second cylindrical member is

inside the first cylindrical member. In response, claims 45-47 have been amended to recite that the first cylindrical member is pulled relative to the second cylindrical member to expand the stent and indwell the stent in the target portion.

(c) The Examiner is unclear as to which cylindrical member is held with respect to the forceps channel because the recitations contradict each other. Applicants respectfully submit that the second cylindrical member is held and in a separate step from both of the cylindrical members being pulled out of the forceps channel (i.e., after release of the holding).

(d) With regard to claim 47 only, the Examiner argues that the same recites “holding a target portion between the holding mechanism ... and the second cylindrical member to regulate the movement of the second cylindrical member.” The Examiner is unclear how (1) the target can be held between the holding mechanism and the second cylindrical member and (2) how doing so regulates the movement of the second cylindrical member. In response, claim 47 has been amended to clarify that a relative position is held between the holding mechanism and the second cylindrical member.

Accordingly, it is respectfully requested that the rejection of claims 3-7 and 45-47 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 45-47 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully submit that such objections are overcome by the amendments and arguments discussed above made in response to the rejection under 35 U.S.C. 112, second paragraph.

In the Official Action, the Examiner rejects claims 1, 2, 8-11, 13-15 and 17-19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,514,261 to Randall et al., (hereinafter "Randall"). Furthermore, the Examiner rejects claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Randall.

In present claim 1, a second cylindrical member includes a holding mechanism which defines a relative position of the second cylindrical member with respect to an endoscope. On the other hand, considering the equivalent structure in Randall as indicated by the Examiner, the middle tube (tube spring) 12 or the inner tube 14 needs to include a collar 98 of the housing 100, but there is no such disclosure.

With regard to the rejection of claims 1, 2, 8-11, 13-15 and 17-19 under 35 U.S.C. § 102(b), a stent delivery system having the features discussed above and as recited in independent claim 1 is nowhere disclosed in Randall. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by Randall. Accordingly, independent claim 1 patentably distinguishes over Randall and is allowable. Claims 2, 8-11, 13-15 and 17-19 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 2, 8-11, 13-15 and 17-19 under 35 U.S.C. § 102(b).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejection of claims 21 and 22 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 21 and 22 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 21 and 22 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spineff
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm